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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,479

Applicant(s)

PHILIPPE ET AL.

Examiner

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-40 is/are pending in the application.
- 4a) Of the above claim(s) 29,30 and 38-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-28 and 31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Filling in forms using a wrapper. Claims 21-28 and 31-37

Species II: Filling in forms using pattern matching. Claims 29, 30, and 38-40

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the

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case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Steven Cahill (Reg. No. 44,578) on January 14, 2004 a provisional election was made without traverse to prosecute the invention of Species I, claims 21-28 and 31-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 29, 30, and 38-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-24, 26-28, 33-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Excite shopping site (which utilizes Netbot/Jango shopping agents), as disclosed in the following articles (which were provided to Applicant in the parent application):

- (A) "The Once and Future Mall"
- (B) "The Promise of Internet Megastores"
- (C) "Excite Scoops Up NetBot Shopping Agent"
- (D) "Shopping Agents Help Consumers Find the Best Deals"
- (E) "'Agents' Surf Web for Best Online Buys,"

in view of Kushmerick et al. (U.S. Patent No. 6,304,870).

Excite discloses a method for effecting transactions across a plurality of vendors in an internet environment, wherein a user purchases each of a plurality of items the user finds independent of the vendors, comprising:

[Claim 21] displaying the plurality of items for purchase, the plurality of items drawn from the plurality of vendors ("Agents' Surf Web for Best Online Buys": ¶ 1, 6);

receiving from the user a selection of items to purchase from the plurality of items, the selection of items comprising items from at least two vendors from the plurality of vendors ("Agents' Surf Web for Best Online Buys": ¶ 1, 6);

mapping the selection of items to purchase to a set of vendors from the plurality of vendors ("The Once and Future Mall": ¶ 10);

determining a plurality of forms corresponding to the set of vendors for the selection of items, each form in the plurality of forms comprising at least one attribute ("The Once and Future Mall": ¶ 10 -- Inherent to being able to automatically fill out forms for different vendors with the shopper's information);

filling in the plurality of forms ("The Once and Future Mall": ¶ 10);

submitting the plurality of forms to the set of vendors ("The Once and Future Mall": ¶ 10, 11);

[Claim 26] wherein providing to the user the plurality of items for purchase further comprises:

searching the internet environment for the plurality of items matching a set of user specified criterion ("Agents' Surf Web for Best Online Buys": ¶ 1, 6); and

displaying the first web page comprising the plurality of items matching the set of user specified criterion ("Agents' Surf Web for Best Online Buys": ¶ 1, 6).

Excite discloses a system for effecting transactions across a plurality of vendors in an internet environment, wherein a user purchases each of a plurality of items the user finds independent of the vendors, comprising:

[Claim 33] a client system ("Agents' Surf Web for Best Online Buys": ¶ 1, 6);

a server in communication with the client system ("Agents' Surf Web for Best Online Buys": ¶ 1, 6);

wherein the client system is configured to display to the user the plurality of items for purchase, the plurality of items drawn from the plurality of vendors (“Agents’ Surf Web for Best Online Buys”: ¶ 1, 6);

wherein the client system is configured to receive from the user a selection of items to purchase from the plurality of items, the selection of items comprising items from at least two vendors from the plurality of vendors (“Agents’ Surf Web for Best Online Buys”: ¶ 1, 6);

wherein the server is configured to map the selection of items to purchase to a set of vendors from the plurality of vendors (“The Once and Future Mall”: ¶ 10);

wherein the server is configured to determine a plurality of order entry forms corresponding to the set of vendors for the selection of items, each order entry form in the plurality of order entry forms comprising at least one attribute (“The Once and Future Mall”: ¶ 10 -- Inherent to being able to automatically fill out forms for different vendors with the shopper’s information);

wherein the server is configured to fill in the plurality of order entry forms (“The Once and Future Mall”: ¶ 10); and

wherein the server is configured to submit the plurality of order entry forms to the set of vendors (“The Once and Future Mall”: ¶ 10, 11).

As per claims 21-24, 26, 33-35, and 37, Excite does not explicitly provide the details of how order forms are transmitted to their respective vendors; however, Excite implies that such functionality is performed:

...A consumer sees only Jango's software within his Web browser; when it is time to buy, Jango automatically fills out the forms with the shopper's details, hiding the rigmarole of each store's interface. To a shopper it would seem as if different sites were as alike as the departments in a megastore.

...In a sense, NetMarket and Shopping.com are shopping agents themselves. They have no warehouses and never handle the products they sell; instead, they search for bargains, bring them to customers under a single interface, and transmit the orders back to the original source-just like Netbot. ("The Once and Future Mall": ¶ 10-11)

Therefore, Excite must inherently use some form filling method for determining which order forms to send to which vendors. Kushmerick is directed toward an Internet shopping environment in which a wrapper program is used to identify and extract product-related data from a web page (col. 2, line 43 through col. 3, line 13). The claimed invention fills in forms by extracting relevant data using a wrapper.

Kushmerick's wrapper is disclosed as being useful for extracting data (found in a web page) that is deemed relevant to an Internet shopping transaction (e.g., description, price, and manufacturer of a product) and it provides a solution to the prior art problem of a user wasting "copious time and effort searching for appropriate on-line stores or other product information sources" (col. 1, lines 28-30). Kushmerick's wrapper extracts the type of data that is relevant to Excite's order forms (e.g., description, price, and manufacturer of a product); therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize Kushmerick's wrapper to extract the data necessary to fill in Excite's order forms (e.g., description, price, and manufacturer of a product) in order to prevent a user (e.g., an

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Internet shopper or the Excite server) from wasting "copious time and effort searching for appropriate on-line stores or other product information sources," especially product information that is needed to submit an order form, as per claims 21 and 33. Since Excite teaches that order forms are submitted to various vendors, the Examiner submits that the Excite-Kushmerick combination yields the recited steps of filling in an order form for each respective vendor using a wrapper program each time, thereby addressing claims 22-24, 34, and 35).

[Claims 27, 28] Claims 27 and 28 recite limitations already addressed by the rejection of claims 21-24 and 33-35 above; therefore, the same rejection applies.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Excite shopping site (which utilizes Netbot/Jango shopping agents), as disclosed in the following articles (which were provided to Applicant in the parent application):

- (A) "The Once and Future Mall"
- (B) "The Promise of Internet Megastores"
- (C) "Excite Scoops Up NetBot Shopping Agent"
- (D) "Shopping Agents Help Consumers Find the Best Deals"
- (E) "'Agents' Surf Web for Best Online Buys,"

in view of Kushmerick et al. (U.S. Patent No. 6,304,870), as applied to claim 27 above, and *further in view of* Hartman et al. (U.S. Patent No. 5,960,411).

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[Claim 31] While Excite does not explicitly disclose the claimed confirmation operation, Hartman describes an online ordering method which allows a user to view his/her order after all order fields have been filled in and before the order is officially confirmed (Figs. 1a, 1b, 1c) in order to allow the user to make any order corrections before the order is sent in. Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to pass control to the user of the Excite shopping site after filling the plurality of order entry forms, wherein the user performs a confirming operation prior to submitting the plurality of order entry forms to the set of vendors in order to ensure that all order information is accurate.

7. Claims 32 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Excite shopping site (which utilizes Netbot/Jango shopping agents), as disclosed in the following articles (which were provided to Applicant in the parent application):

- (A) "The Once and Future Mall"
- (B) "The Promise of Internet Megastores"
- (C) "Excite Scoops Up NetBot Shopping Agent"
- (D) "Shopping Agents Help Consumers Find the Best Deals"
- (E) "'Agents' Surf Web for Best Online Buys,"

in view of Kushmerick et al. (U.S. Patent No. 6,304,870), as applied respectively to claims 27 and 33 above, and *further in view of* the product "Reseller Business

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Center," which is sold by Ingram Micro Inc. and is disclosed in the following articles (which were provided to Applicant in the parent application):

(F) "Ingram Micro Adds Powerful Electronic Commerce Tools to Its Web Site"

(G) "A Wholesale Extranet -- A Sweeping Web-Based Project is Helping Computer Distributor Ingram Micro Redefine Its Role in the Supply Chain" (please note that the product was released as early as May 5, 1997, as per "Ingram Micro Adds Powerful Electronic Commerce Tools to Its Web Site").

[Claims 32, 36] While Excite does not explicitly disclose the claimed tracking of confirmation information, "Reseller Business Center" is a third-party reseller web site that enables real-time ordering and order status ("Ingram Micro Adds Powerful Electronic Commerce Tools to Its Web Site" -- page 1, ¶1, 4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to track confirmation information returned by the set of vendors in response to submitting the plurality of order entry forms to the set of vendors as part of the Excite shopping site in order to provide the old and well-known benefit of reassurance that the user's order has been received and also to provide the user with a warning if a vendor does not have a particular item in stock.

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Excite shopping site (which utilizes Netbot/Jango shopping agents), as disclosed in the following articles (which were provided to Applicant in the parent application):

- (A) "The Once and Future Mall"
- (B) "The Promise of Internet Megastores"
- (C) "Excite Scoops Up NetBot Shopping Agent"
- (D) "Shopping Agents Help Consumers Find the Best Deals"
- (E) "'Agents' Surf Web for Best Online Buys,"

in view of Kushmerick et al. (U.S. Patent No. 6,304,870), as applied to claim 21 above, *further in view of* Hartman et al. (U.S. Patent No. 5,960,411), as applied to claim 31 above, and even *further in view of* the product "Reseller Business Center," which is sold by Ingram Micro Inc. and is disclosed in the following articles (which were provided to Applicant in the parent application):

- (F) "Ingram Micro Adds Powerful Electronic Commerce Tools to Its Web Site"
- (G) "A Wholesale Extranet -- A Sweeping Web-Based Project is Helping Computer Distributor Ingram Micro Redefine Its Role in the Supply Chain" (please note that the product was released as early as May 5, 1997, as per "Ingram Micro Adds Powerful Electronic Commerce Tools to Its Web Site"), as applied to claim 32 above.

[Claim 25] Claim 25 recites limitations already addressed by the rejections of claims 21, 31, and 32 above; therefore, the same rejections apply.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Christianson et al. (U.S. Patent No. 6,085,186) -- Discloses the use of wrappers to execute queries on the Internet for product information.

Walter ("Junglee Tries to Tame the Data Jungle") -- Discusses Junglee's virtual database (VDB) technology.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

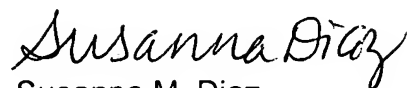
or faxed to:

(703)305-7687 [Official communications; including
After Final communications labeled
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(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.



Susanna M. Diaz

Patent Examiner

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January 16, 2004